

## REMARKS

This Response is filed in Response to the Final Office Action dated April 25, 2002. A Request for Continued Examination is filed herewith. Claims 1 to 13 and 15 to 40 were previously pending in this application. Claim 14 was canceled previously. Claims 1, 10, 17, 19, 20, 27, 29 and 36 are amended in this response. Claim 35 is being canceled without prejudice or disclaimer. A request to amend Figure 2 is being made in a Petition submitted herewith. No new matter is being added. A petition for a one month extension of time to respond to the Office Action is submitted herewith. Checks in the amount of \$110.00 and \$740.00 are submitted herewith to cover the cost of the one-month extension and Request for Continued Examination. Please charge Deposit Account No. 02-1818 for any insufficiency or credit for any overpayment.

In the final Office Action, the amendment of February 6, 2002 was objected to under 35 U.S.C. § 132 for adding new matter into added Claims 17 and 19. Claims 17 and 19 were rejected under 35 U.S.C. § 112, first paragraph, accordingly. Claims 1 and 5 were rejected under 35 U.S.C. § 102(b) as being anticipated by 'Tic-Tac-Dough', at:

[www.angelfire.com/wrestling3/jay\\_anton/tictacpages/-tictacdough.html](http://www.angelfire.com/wrestling3/jay_anton/tictacpages/-tictacdough.html), ("*Tic-Tac-Dough*"). Claims 27 to 29 and 35 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,322,309 to Thomas et al. ("*Thomas*"). Claims 2, 8, 9 to 11, 15, 20, 23, 30 and 36 to 38 were rejected under 35 U.S.C. § 103(a) as being obvious in view of *Tic-Tac-Dough* and *Thomas*. Claims 3, 4, 12, 13, 21, 22, 31 and 32 were rejected under 35 U.S.C. § 103(a) as being obvious in view of *Thomas* or *Tic-Tac-Dough*, *Thomas* and U.S. Patent No. 6,231,422 to Mayerhoff ("*Mayerhoff*"). Claims 6, 7, 24 and 25 were rejected under 35 U.S.C. § 103(a) as being obvious in view of *Tic-Tac-Dough* or *Tic-Tac-Dough* and *Thomas* and in further view of U.S. Patent No. 5,647,798 to Faciglia ("*Faciglia*"). Claims 16, 17, 18, 19 and 26 were rejected under 35 U.S.C. § 103(a) as being obvious in view of *Tic-Tac-Dough* or *Tic-Tac-Dough* and *Thomas* or *Tic-Tac-Dough*, *Thomas* and *Mayerhoff* and in further view of U.S. Patent No. 5,882,259 to Holmes, Jr. et al. ("*Holmes*"). Claims 33, 34, 39 and 40 were rejected under 35 U.S.C. § 103(a) as being obvious in view of *Thomas* or *Thomas* and *Tic-Tac-Dough*, and in further view of U.S. Patent No. 6,001,016 to Walker et al. ("*Walker*").

In the previous response of February 6, 2002, Applicants noted that in the personal interview courteously granted to Applicants' representatives on December 5,

2001, the Examiners indicated that amending the claims to recite that the player receives credits for the selections while at the same time accumulating award symbols to potentially win a jackpot award would further the prosecution of the present invention in view of U.S. Patent No. 5,931,467 to Kamille ("*Kamille*"). Applicants amended the claims accordingly in various ways pursuant to the invention as disclosed. Applicants note that the amendments appear to have overcome the rejections based on *Kamille*, wherein the Applicants are now faced with art not previously cited.

In view of the new art, Claim 1 as amended herein is now directed to a gaming device having a bonus scheme, which includes: (i) a plurality of selections; (ii) a plurality of credit symbols associated with said selections; (iii) a plurality of award symbols associated with said selections; (iv) a winning combination of award symbols and a jackpot award associated with said winning combination of award symbols, wherein the winning combination of award symbols requires X number of said award symbols; (v) at least one award, less than the jackpot award, associated with at least one different combination of award symbols, the different combination requiring a plurality of but less than X number of symbols; (vi) a display device adapted to display the selections, credit symbols and award symbols to a player; and (vii) a processor which communicates with the display device, provides a number of credits to the player when the player chooses each of the selections having an associated credit symbol, accumulates the award symbols when the player chooses each selection having an associated award symbol, provides the player the jackpot award when the accumulated award symbols reach said winning combination of award symbols and provides the award if the accumulated award symbols reach the different combination of award symbols having at least a plurality of but less than X number of award symbols.

The prior art of record does not disclose, teach or suggest Claim 1 as amended. *Tic-Tac-Dough* does not disclose a game wherein besides winning credit values, the player also wins a jackpot for finding "Tic", "Tac" and "Dough" behind three squares or another award if the player only finds "Tic" and "Tac" or "Tic" and "Dough" or "Tac" and "Dough" behind two squares.

Moreover, a game that provides a jackpot award for finding only two award symbols cannot meet the limitations of Claim 1 as amended. For example, Claim 1 is not taught by a game wherein besides winning credit values, the player also wins a

jackpot for finding "Tic" and "Tac" behind two squares or another award if the player only finds "Tic" behind one square. The reason is because the lesser award of Claim 1 requires a plurality of award symbols. Support for the added limitations for Claim 1 as amended can be found in the disclosure in connection with Figure 8.

*Thomas* discloses a Monopoly™ embodiment, wherein the player wins credits for obtaining a symbol and extra credits if the player completes a group of symbols, e.g., blue symbols. In *Thomas*, however, there is only one type of symbol, i.e., a symbol that yields credits and that belongs to a group. The claims as amended herein on the other hand include two types of symbols, credit symbols that yield credits, and award symbols that yield increasingly greater amounts until reaching an ultimate jackpot award.

Moreover, Monopoly™ requires the completion of a group of symbols for an additional award and does not provide a lesser award for completing only a portion of a group. The claims as amended herein on the other hand include additional awards for obtaining less than the number of symbols required for winning a jackpot award.

The present invention includes two types of symbols, credit symbols and award symbols. For example, the specification in connection with Fig. 8 discloses, "Every time the player selects a pyramid he is awarded a predetermined number of credits. In one preferred embodiment, the first pyramid is worth 25, the second 25, the third 50, the fourth 150, the fifth 250, the sixth 4500 and the seventh 995,500 credits." In addition to the awards associated with the pyramid symbols, i.e., the award symbols (symbol 120 of Fig. 8), the player wins credits for selecting a credit symbol (symbol 118 of Fig. 8) that reveals a number of credits.

Accordingly, Claim 1, as amended herein, and Claims 2 to 9 and Claims 16 and 17 which depend from Claim 1 are each patentably distinguished over the art of record and are in condition for allowance. It should be appreciated that the amendment also renders: (i) the rejection of Claims 2, 8 and 9 in view of *Tic-Tac-Dough* and *Thomas*; (ii) the rejection of Claims 3 and 4 in view of *Thomas* or *Tic-Tac-Dough*, *Thomas* and *Mayerhoff*, (iii) the rejection of Claims 6 and 7 in view of *Tic-Tac-Dough* or *Tic-Tac-Dough* and *Thomas* and in further view of *Faciglia*; and (iv) the rejection of Claims 16 and 17 in view of *Tic-Tac-Dough* or *Tic-Tac-Dough* and *Thomas* or *Tic-Tac-Dough*, *Thomas* and *Mayerhoff* and in further view of *Holmes* moot.

Additionally, the rejection of Claims 6 and 7 based on *Faciglia* is improper because in *Faciglia*, the player does not pick a selection, rather the player spins a number of reels, wherein the reels generate a number of symbols. A person of ordinary skill in the art who is contemplating a game in which players pick selections as is the case in the present invention as claimed would not therefore be inclined to look at games that randomly generate a plurality of symbols upon a player input. Obviousness must include some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art that would lead an individual to combine the teachings of the references in the manner of the claimed invention. In re Fritch, 23 U.S.P.Q. 2d 1780, 1783-84 (Fed. Cir. 1992); see also In re Lee 61 U.S.P.Q. 2d 1430, 1434-35 (Fed. Cir. 2002) (The prior art must suggest the desirability of such modification). It is also well settled law that obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the claimed invention. ATD Corp v. Lydall, Inc., 48 U.S.P.Q. 2d 1321, 1329 (Fed. Cir. 1998). Nowhere does the prior art suggest the desirability of the combination of elements recited in dependent Claims 6 and 7.

Claim 10 as amended herein is directed to a method of operating a bonus round of a gaming device. The method includes the steps of: (i) triggering said bonus round; (ii) displaying a plurality of selections to a player; (iii) picking one of the selections; (iv) displaying a symbol associated with the picked selection; (v) accumulating the symbol if the symbol associated with the picked selection is an award symbol, wherein at least one of the awards is associated with one of the award symbols; (vi) providing the player an award if the symbol associated with the picked selection is a credit symbol; (vii) repeating steps (c) through (f) until a number of selections are picked; (viii) providing the player a jackpot award if the accumulated award symbols reach a predetermined number of award symbols; and (ix) providing the player an award, less than the jackpot award, if the award symbols accumulate to at least two but less than the predetermined number of award symbols.

Amended Claim 10 includes the step of providing the player an award, less than a first jackpot award, if the accumulated award symbols reach at least two symbols but less than a predetermined number of award symbols needed for the jackpot award. For

each of the reasons discussed above, Claim 10 as amended is patentably distinguished over the art of record and in condition for allowance.

*Tic-Tac-Dough* does not disclose a game wherein besides winning credit values, the player also wins a jackpot for finding "Tic", "Tac" and "Dough" behind three squares or another award if the player only finds "Tic" and "Tac" or "Tic" and "Dough" or "Tac" and "Dough" behind two squares. Monopoly™ does not disclose a game wherein besides winning credit values, the player also wins a jackpot for finding three blue symbols or another award if the player only finds two blue symbols. Monopoly requires that, "supplemental coin(s) or credit(s) are awarded in the Monopoly™ game if the property selection 'completes' a particular color group (e.g., yellow, red, green, blue, etc.) or property group (e.g., railroads or utilities)." [col. 11, lines 44 to 48, emphasis in original]

Because Claim 10 as amended herein is patentably distinguished over the art of record, Claims 11, 12, 13, 15, 18 and 19 which directly or indirectly depend from Claim 10 are each patentably distinguished over the art of record and are in condition for allowance. It should be appreciated that the amendment also renders: (i) the rejection of Claim 11 in view of *Tic-Tac-Dough* and *Thomas*; (ii) the rejection of Claims 12 and 13 in view of *Thomas* or *Tic-Tac-Dough*, *Thomas* and *Mayerhoff*, and (iii) the rejection of Claims 18 and 19 in view of *Tic-Tac-Dough* or *Tic-Tac-Dough* and *Thomas* or *Tic-Tac-Dough*, *Thomas* and *Mayerhoff* and in further view of *Holmes* moot.

Claims 17 and 19 have been amended to comply with the specification as originally filed. Applicants therefore respectfully submit that the rejection to the specification under 35 U.S.C. § 132 and the rejection to Claims 17 and 19 under 35 U.S.C. § 112 have been overcome.

Similar to amended Claims 1 and 10, Claim 20 as amended herein is directed to a gaming device in which the processor: (i) provides the player with a number of picks of the selections; (ii) provides the player with an amount of credits for each pick of one of the selections having an associated credit symbol; (iii) provides the player an amount of credits for at least two picks of one of the selections having an associated award symbol; and (iv) also provides the player a jackpot award if the player selects a predetermined number of selections having associated award symbols within the player's number of picks of selections. For each of the reasons discussed above,

therefore, Claim 20 as amended is patentably distinguished over the art of record and is in condition for allowance.

*Tic-Tac-Dough* does not disclose a game wherein besides winning credit values, the player also wins a jackpot for finding "Tic", "Tac" and "Dough" behind three squares or another award for at least two picks of "Tic", "Tac" or "Dough". Monopoly™ does not disclose a game wherein besides winning credit values, the player also wins a jackpot for finding three blue symbols or another award if the player only finds two blue symbols.

Because Claim 20 as amended is patentably distinguished over the art of record, Claims 21 to 26 which depend from Claim 20 are each patentably distinguished over the art of record and are in condition for allowance. It should also be appreciated that: (i) the rejection of Claim 23 in view of *Tic-Tac-Dough* and *Thomas*; (ii) the rejection of Claims 21 and 22 in view of *Thomas* or *Tic-Tac-Dough*, *Thomas* and *Mayerhoff*; (iii) the rejection of Claims 24 and 25 in view of *Tic-Tac-Dough* or *Tic-Tac-Dough* and *Thomas* and in further view of *Faciglia*; and (iv) the rejection of Claim 26 in view of *Tic-Tac-Dough* or *Tic-Tac-Dough* and *Thomas* or *Tic-Tac-Dough*, *Thomas* and *Mayerhoff* and in further view of *Holmes* are each rendered moot by the above described distinctions. Moreover, the rejection of Claims 24 and 25 based on *Faciglia* is improper as described above. Further, the rejection of Claim 23 is improper because Claim 23 includes a functional symbol, which is admittedly not found in *Tic-Tac-Dough* and *Thomas* (See Office Action, page 7).

Claim 27 as amended is directed to a gaming device in which the processor: (i) provides the player with a number of picks of the selections; (ii) provides the player with an amount of credits for each pick of one of the selections having an associated credit symbol; (iii) accumulates the award symbols for each pick of one of the selections having an associated award symbol; and (iv) provides the player an award that varies based on the number of accumulated award symbols (at least two) associated with the selections picked by the player, wherein the award non-linearly increases as the number of accumulated award symbols increases. For each of the reasons discussed above, therefore, Claim 27 as amended and Claim 28 which depends therefrom are patentably distinguished over the art of record and are in condition for allowance.

*Tic-Tac-Dough* does not disclose a game wherein besides winning credit values, the player also wins a jackpot for finding "Tic", "Tac" and "Dough" behind three squares or another award for at least two picks of "Tic", "Tac" or "Dough". *Monopoly*<sup>TM</sup> does not disclose a game wherein besides winning credit values, the player also wins a jackpot for finding three blue symbols or another award if the player only finds two blue symbols. Additionally, *Thomas* does not disclose awards that non-linearly increase in addition to credit values. *Thomas* discloses only one type of symbol and does not include award symbols as described above. Second, *Thomas* discloses an accumulation of awards, not a linear or non-linear increase of an award. The bonus award provided by *Thomas* for completing a set of selections is a single award and therefore cannot increase or decrease.

Claim 29 as amended herein is directed to a method of operating a game of a gaming device. The method includes, among other steps, the steps of: (i) enabling the player to make a number of picks of said selections; (ii) accumulating the symbol if the symbol is an award symbol, (iii) providing the player at least one credit if the symbol is a credit symbol; and (iv) providing the player an additional award that varies based on at least two accumulated award symbols, wherein the additional award non-linearly increases as the number of accumulated award symbols increases. For each of the reasons discussed above including the additional ("non-linear") distinction discussed in connection with Claim 27, amended Claim 29 and Claims 30 to 34 which depend therefrom are each patentably distinguished over the art of record and are in condition for allowance.

It should be appreciated that: (i) the rejection of Claim 30 in view of *Tic-Tac-Dough* and *Thomas*; (ii) the rejection of Claims 31 and 32 in view of *Thomas* or *Tic-Tac-Dough*, *Thomas* and *Mayerhoff*; and (iii) the rejection of Claims 33 and 34 in view of *Thomas* or *Thomas* and *Tic-Tac-Dough*, and in further view of *Walker* are each rendered moot by the above described distinctions.

Claim 35 has been canceled without prejudice or disclaimer.

Claim 36 as amended is directed to a gaming device wherein at least one credit is provided to the player for each selection of a credit symbol. A winning combination of award symbols is provided. A jackpot award is provided to the player if, for each of the provided number of picks, the player picks the selections having associated award

symbols which form the winning combination of award symbols. That is, the player does not pick a credit symbol within the provided number of picks. Nowhere does the prior art disclose a game that includes two types of symbols, and provides a jackpot award if each of the player's selections yields one type of symbol. Both *Tic-Tac-Dough* and *Thomas* enable the player to win credits and a jackpot type award during the same game play. Also, as discussed above, *Thomas* only provides one type of symbol, wherein the symbols are grouped to potentially provide an additional award. For each of these reasons, Claim 36 as amended and Claim 37 which depends therefrom are patentably distinguished over the art of record and are in condition for allowance.

Claim 38 is directed to a method of operating a bonus game of a gaming device which includes, among other steps, the steps of: (i) providing credits to the player in response to a plurality of the picked selections; (ii) accumulating jackpot award symbols associated with the picked selections; and (iii) providing a jackpot award to the player if the player accumulates a pre-determined amount jackpot award symbols, wherein the bonus game is arranged such that odds of obtaining the pre-determined award symbols is low enough such that the jackpot award can be at least approximately \$1,000,000. Nowhere does the prior art disclose the above dollar value or any denomination in a reasonable range of such dollar value. In the Office Action, there is no attempt to even address this limitation. Claim 38 and Claims 39 and 40, which depend therefrom are therefore patentably distinguished over the art of and in condition for allowance.

It should be appreciated that the rejection of Claims 39 and 40 in view of *Thomas* or *Thomas* and *Tic-Tac-Dough*, and in further view of *Walker* are each rendered moot by the above described distinctions. Further, the objection to the drawings, which pertains to the subject matter of Claims 33, 34, 39 and 40 will be overcome if the Examiner accepts the proposed changes to Figure 2 in the Request submitted herewith.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding the above amendment, Applicants respectfully requests that the Examiner contact the Applicants' attorney, Adam Masia, at (312) 807-4284 to discuss the amendment.



Attached hereto is a marked-up version of the amendments made to the specification. The attached page is captioned "Version with markings to show changes made."

Respectfully submitted,

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## VERSION WITH MARKINGS TO SHOW CHANGES MADE

### In the Claims:

Claim 1 has been amended as follows:

1. (Twice Amended) A gaming device having a bonus scheme comprising:
  - a plurality of selections;
  - a plurality of credit symbols associated with said selections;
  - a plurality of award symbols associated with said selections;
  - a winning combination of award symbols and a jackpot award associated with said winning combination of award symbols, the winning combination of award symbols requiring X number of said award symbols;
    - at least one award less than the jackpot award associated with a combination of award symbols different from the winning combination, the different combination requiring a plurality of but less than X number of award symbols;
  - a display device adapted to display the selections, credit symbols and award symbols to a player; and
  - a processor which communicates with the display device, provides a number of credits to the player when the player chooses each of the selections having an associated credit symbol, accumulates the award symbols when the player chooses each selection having an associated award symbol, ~~provides a number of credits to the player when the player chooses at least one selection having an associated award symbol, and~~ provides the player the jackpot award when the accumulated award symbols reach said winning combination of X number of award symbols and provides the award if the accumulated award symbols reach the different combination of award symbols having less than X number of award symbols.

Claim 10 has been amended as follows:

10. (Twice Amended) A method of operating a bonus round of a gaming device, said method comprising the steps of:

- (a) triggering said bonus round;
- (b) displaying a plurality of selections to a player;
- (c) picking one of the selections;
- (d) displaying a symbol associated with the picked selection;
- (e) ~~providing the player an award and~~ accumulating the symbol if the symbol associated with the picked selection is an award symbol, wherein at least one ~~said~~ award is associated with one of the award symbols;
- (f) providing the player an award if the symbol associated with the picked selection is a credit symbol;
- (g) repeating steps (c) through (f) until a number of selections are picked;
- ~~(g) (h)~~ providing the player a jackpot award if the accumulated award symbols reach a predetermined number of award symbols; and
- ~~(h) — repeating steps (c) through (g) until a number of selections are picked.~~
- (i) providing the player an award less than the jackpot award if there is at least two but less than the predetermined number of accumulated award symbols.

Claim 17 has been amended as follows:

17. (Amended) The ~~method~~ gaming device of Claim 1, which includes a selection confirmation indicator connected to the processor which enables the player to confirm ~~each selection~~ at least one selection picked by the player.

Claim 19 has been amended as follows:

19. (Amended) The method of Claim 12, which includes enabling the player to confirm ~~each selection~~ at least one selection picked by the player.

Claim 20 has been amended as follows:

20. (Amended) A gaming device having a game comprising:

- a plurality of selections;
- a plurality of credit symbols associated with a plurality of said selections;
- a plurality of award symbols associated with a plurality of said selections;
- a display device adapted to display the selections, credit symbols and award symbols to a player; and

a processor in communication with the display device, said processor providing the player with a number of picks of the selections, providing the player with an amount of credits for each pick of one of the selections having an associated credit symbol, providing the player with an amount of credits for at least ~~one pick of one~~ two picks of the selections having an associated award symbol, and providing the player a jackpot award if the player selects a predetermined number of selections having associated award symbols with the player's number of picks of the selections.

Claim 27 has been amended as follows:

27. (Amended) A gaming device having a game comprising:

- a plurality of selections;
- a plurality of credit symbols associated with a plurality of said selections;
- a plurality of award symbols associated with a plurality of said selections;
- a display device adapted to display the selections, credit symbols and award symbols to a player; and

a processor in communication with the display device, said processor providing the player with a number of picks of the selections, providing the player with an amount of credits for each pick of one of the selections having an associated credit symbol, accumulating the award symbols for each pick of one of the selections having an associated award symbol, and providing the player an award that varies based on the number of accumulated award symbols associated with the selections picked by the player, the number being at least two, wherein said award non-linearly increases as the number of accumulated award symbols increases.

Claim 29 has been amended as follows:

29. (Amended) A method of operating a game of a gaming device, said method comprising the steps of:

- (a) displaying a plurality of selections to a player;
- (b) enabling the player to make a number of picks of said selections;
- (c) displaying a symbol associated with each picked selection;
- (d) accumulating the symbol if said symbol is an award symbol;
- (e) providing the player at least one credit if the symbol is a credit symbol;

and

(f) providing the player an additional award that varies based on the number of at least two accumulated award symbols, wherein said additional award non-linearly increases as the number of accumulated award symbols increases.

Claim 35 has been canceled without prejudice or disclaimer.

Claim 36 has been amended as follows:

36. (Amended) A gaming device comprising:

- a plurality of selections;
- a plurality of credit symbols associated with a plurality of said selections;
- a plurality of award symbols associated with a plurality of said selections;
- a winning combination of award symbols;
- a processor providing a number of picks of the selections;
- at least one credit provided to a player for each picked selection having an associated credit symbol; and
- ~~at least one credit provided to the player for at least one picked selection having an associated award symbol; and~~
- a jackpot award provided to the player if, ~~within the provided number of picks of the selections for each of the provided number of picks,~~ the player picks the selections having associated award symbols which are form the winning combination of award symbols.